

### **REMARKS**

The Patent and Trademark Non-final Office Action dated September 17, 2007, has been carefully considered. The Examiner's rejection of claims 1 - 20, and 22 - 34 in view of the cited art is noted.

With this correspondence, Applicant submits replacement drawing figures, Figs. 1 - 12, to correct minor illegible and non-conforming matter in the corresponding drawing figures as originally filed, and as more specifically detailed on the accompanying annotated sheets of Figs. 1 - 12 as filed. Applicant believes the specification of this application is enhanced by these corrected drawing figures. No new matter is introduced in the replacement drawing figures, Figs. 1 - 12.

Applicant has amended the specification page 10, line 8 through page 11, line 7 to correct a minor typographical error. No new matter has been added by this amendment.

Applicant appreciates the Examiner's position with respect to claim 21 being allowable if written in independent form, including all of the limitations of the base claim and any intervening claims.

#### **Claim Rejections under 35 U.S.C. §103(a):**

A. The Examiner's rejection of claims 1 - 11 under 35 U.S.C. §103(a) as being unpatentable over Ho et al., U.S. Patent No. 6,213,780 ("Ho") in view of Mascarenhas, U.S. Patent No.

7,162,432 ("Mascarenhas") is noted.

**Claim 1:** As to claim 1, the Examiner recites the abstract and Fig. 17 of Ho as having relevant disclosure features more specifically set forth on pages 2 - 3 of the Office Action. The Examiner concedes and admits Ho lacks any disclosure as to assessing and understanding personality themes as a tool in career assessment. The Examiner, however, finds adequate support for assessing and understanding personality themes as a tool in career assessment in Mascarenhas.

Use of Ho and or Mascarenhas to in any way supply the admitted or conceded missing disclosed or claimed subject matter of Applicant's disclosed and claimed subject matter in claim 1 of the pending application must satisfy the factual inquiry requirements of *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), namely:

1. determining the scope and content of the prior art;
2. ascertaining the differences between the claimed invention and the prior art; and
3. resolving the level of ordinary skill in the pertinent art.

For the second *Graham* factor, ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, MPEP §2111, and considering the invention and the prior art as a whole, MPEP §2141.02.

The disclosed system and method of the present invention in

the pending application provides a user with the assessment tools to understand four essential career related criteria: (i) their values (what is important to them); (ii) their skills (what they are good at); (iii) their interests (naturally occurring urges towards a subject matter or industry); and (iv) their personality (the environment that supports them best) [Application 10/768,929, page 3, lines 9 - 18]. With the profile recording sheet (Application 10/768,929, Claim 1), the user creates and writes an action plan consistent with the assessment results and as such is invested in the optimum outcome for a career change or choice based upon the assessment [Application 10/768,929, page 4, line 16 through page 6, line 6]. The results written and edited by the user can then be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10]. This novel system and method of the present invention in the pending application is disclosed and claimed in a manual embodiment [Application 10/768,929, page 5, line 24 through page 6, line 6] and stand-alone or interactive electronic embodiments [Application 10/768,929, page 6, lines 7 - 10].

Considered as a whole, Ho is a computer aided learning and counseling from a profile which is silent as to assessing and understanding personality themes [Examiner's admission, page 2 of the Office Action]. Mascarenhas discloses a "system, wherein a

psychological significance pattern is created by others for the end users enabling them to run custom searches on products, services and jobs." [emphasis added; Office Action page 2]. Both Ho and Mascarenhas are silent as to a user manually using the profile assessment tools with a recording sheet. Further, neither Ho or Mascarenhas are user based assessment tools for career guidance. Ho is principally designed for providing a training regimen for users based upon a job position or selection [see, e.g., Ho, column 2, lines 13 - 16]. Mascarenhas teaches a computer based system for an on-line psychological test to match the user with statistically targeted information. Neither Ho or Mascarenhas singularly or combined satisfy the factual inquiry requirements of *Graham* when matched with the present application as a whole. Thus, Ho and/or Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of independent claim 1.

Accordingly, rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claims 2 - 5:** As to claims 2 - 5, the Examiner recites Fig. 17 and column 5, lines 17 - 23 of Ho as having relevant disclosure.

features more specifically set forth on pages 3 of the Office Action.

Applicant reiterates the traversal of rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above for claim 1. Claims 2 - 5 depend upon an allowable claim, claim 1, and, as such, rejection of claims 2 - 5 under 35 U.S.C. §103(a) as being unpatentable over Ho is likewise traversed.

Further, use of Ho solely, with its admitted and conceded missing subject matter of Applicant's disclosed and claimed subject matter for claims 2 - 5 of the pending application, for rejection based upon 35 U.S.C. §103(a) must satisfy the factual inquiry requirements of *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), namely:

1. determining the scope and content of the prior art;
2. ascertaining the differences between the claimed invention and the prior art; and
3. resolving the level of ordinary skill in the pertinent art.

For the second *Graham* factor, ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, MPEP §2111, and considering the invention and the prior art as a whole, MPEP §2141.02.

Considered as a whole, Ho is a computer aided learning and counseling from a profile which is silent as to assessing and

understanding personality themes [Examiner's admission, page 2 of the Office Action]. Thus, Ho reasonably cannot be interpreted to disclose the aforementioned features of dependent claims 2 - 5.

Accordingly, rejection of claims 2 - 5 under 35 U.S.C. §103(a) as being unpatentable over Ho is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claims 6 - 9:** As to claims 6 - 9, the Examiner concedes and admits neither Ho or Mascarenhas discloses recording sheets using "rows and columns to organize the personality, skills, values and career interests" [Office Action page 3], but opines tabulating and prioritizing data as being known in the art.

Applicant reiterates the traversal of rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above for claim 1. Claims 2 - 5 depend upon an allowable claim, claim 1, and, as such, rejection of claims 2 - 5 under 35 U.S.C. §103(a) as being unpatentable over Ho is likewise traversed. Therefore, claims 6 - 9, depending upon either claim 1, or one of claims 2 - 5, depend upon an allowable claim and, as such, rejection of claims 6 - 9 under 35 U.S.C. §103(a) as being unpatentable over Ho, or Ho in view of Mascarenhas, is likewise traversed.

Further, Applicant reiterates the manual embodiment of the user initiated, written and created action plan consistent with the assessment results and as such is invested in the optimum outcome for a career change or choice based upon the assessment [Application 10/768,929, page 4, line 16 through page 6, line 6]. The results written and edited by the user can then be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10]. The array assembly of this information allows lay-person users to manually implement the methods of the present invention easily and without particular training or skills in logic, data interpretation, and/or statistics [see, e.g., Application 10/768,929, page 2, line 25 through page 3, line 8]. Simply concluding "tabulating and prioritizing data as being known in the art" **ignores this essential aspect of the present invention and does not comport with the requirements** of either *Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Ho and/or Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claims 6 - 9.

Accordingly, rejection of claims 6 - 9 under 35 U.S.C. §103(a) as being unpatentable over Ho/Mascarenhas and the level of the art is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope

and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claims 10 - 11: As to claims 10 - 11, the Examiner concedes and admits Mascarenhas "does not specifically disclose a set of four personality theme (sic) such as organizer, liberator, facilitator, and innovator" but goes on to conclude it would be "obvious to incorporate the four personality categories into the method of Ho/Mascarenhas in order to include more diverse personality themes and therefore attract a larger number of users."

As Applicant has demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's conclusions as to Ho/Mascarenhas and the art ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02.

Further, Applicant reiterates the traversal of rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above for claim 1. Claims 2 - 5 depend upon an allowable claim, claim 1, and, as such, rejection of claims 2 - 5 under 35 U.S.C. §103(a) as being unpatentable over Ho is likewise traversed. Therefore, claims 10 - 11, depending upon either claim 5, and ultimately on claim 1, are allowable and, as such, rejection of claims 10 - 11 under 35



U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas is likewise traversed.

Most importantly, however, the methodology of claims 10 and 11 go to the essential purpose of providing means for a lay person to manually implement the methods of the present invention easily and without particular training or skills in logic, data interpretation, and/or statistics, in order to create and write an action plan consistent with the assessment results and as such is invested in the optimum outcome for a career change or choice based upon the assessment [Application 10/768,929, page 2, line 25 through page 3, line 8; and page 4, line 16 through page 6, line 6].

Simply concluding "obvious to incorporate the four personality categories into the method of Ho/Mascarenhas in order to include more diverse personality themes and therefore attract a larger number of users" ignores this essential aspect of the present invention and does not comport with the requirements of *Graham*, MPEP §2111, and/or MPEP §2141.02. Thus, Ho and/or Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claims 10 - 11.

Accordingly, rejection of claims 10 - 11 under 35 U.S.C. §103(a) as being unpatentable over Ho/Mascarenhas and the level of the art is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 -

determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

B. The Examiner's rejection of claims 12 - 20 and 33 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas, and further in view of U.S. Patent Publication No. 2005/0026119 ("Ellis") is noted.

**Claim 12:**<sup>1</sup> As to claim 12, the Examiner concedes and admits Ho/Mascarenhas do "not disclose tabulating data and transferring them to the scoring sheet." Instead the Examiner relies upon Fig. 5 of Ellis as providing the requisite obviousness element to combine with Ho/Mascarenhas to reject claim 12.

Applicant reiterates the traversal of rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above. Claim 12 depends upon an allowable claim, claim 11, and, as such, rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ho, or Ho in view of Mascarenhas, is likewise traversed.

As with Ho, Ellis is limited to a framework wherein competencies for a career and associated requirements that need to be satisfied to attain the relevant competency are developed

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<sup>1</sup> Although there is no specific discussion expressly directed towards claim 12, Applicant reads the first full paragraph of page 4 of the Office Action to be intended by the Examiner as being so directed.

for advancement purposes [Ellis, abstract]. Since it is directed only towards competency, Ellis does not use assessment tools to understand any essential career related criteria, for example (i) user values (what is important to them); (ii) user skills (what they are good at); (iii) user interests (naturally occurring urges towards a subject matter or industry); and (iv) user personality (the environment that supports them best)

[Application 10/768,929, page 3, lines 9 - 18]. In Ellis, the user does not create and/or write an action plan consistent with the user's assessment results and, as such, the user does not become invested in the optimum outcome for a career change or choice based upon an assessment [Application 10/768,929, page 4, line 16 through page 6, line 6]. Ellis does not provide for assessment results as written and edited by the user to be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10].

As Applicant has demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar conclusions as to Ho/Mascarenhas in further view of Ellis as to claim 12 ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Ho and/or Mascarenhas in further view of Ellis reasonably cannot be

interpreted to disclose the aforementioned features of dependent claim 12.

Accordingly, rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ho/Mascarenhas in further view of Ellis is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claim 13: As to claim 13, the Examiner cites Mascarenhas as disclosing "matching personality snapshot results with career profile (e.g. Pearson correlation coefficient), reviewing description of personality snapshots (See Col. 14, table II), rank personality themes (See Col. 17, 23 - 25 and Fig. 7)."

Applicant reiterates the traversal of rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above. Claim 13 depends upon an allowable claim, claim 12, and, as such, rejection of claim 13 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

As Applicant has further demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on Mascarenhas to reject claim 13 under 35 U.S.C. §103(a) ignores the present invention and does not comport with the requirements of either

*Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 13.

Accordingly, rejection of claim 13 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 14:** As to claim 14, the Examiner cites Mascarenhas as disclosing "providing a roster of a plurality of . . . (e.g. jobs) (See Table II)," [emphasis added] "the user's personality theme ranking (e.g. Pearson correlation coefficient)." The Examiner concedes and admits Mascarenhas fails to specifically disclose "providing the user with sample informational interview" but finds support for this element in Ho (Col. 17, 56 - 57). The Examiner further admits and concedes Ho/Mascarenhas do not "expressly disclose providing a contact person, networking suggestions and sample informational interview to the user" but the Examiner again relies on Ellis for "providing a contact person (e.g. coach) and networking suggestions (e.g. technical resources to the user." The Examiner then concludes that it would have been obvious to incorporate Ho/Mascarenhas into Ellis in order to "design a more efficient customized job search

system." [emphasis added].

Ho (Col. 17, 56 - 57) does not support the contention of the Examiner, either substantively or contextually, but instead discusses (a) use of a computer to perform iterative identification of job candidates (line 56) and (b) accessing the company's job bank periodically for new listings (line 57). Accordingly, rejection of claim 14 under 35 U.S.C. §103(a) based upon Ho is traversed.

Similarly, the Examiner's suggestion that Ellis' "providing a contact person (e.g. coach)" does not address Applicant's disclosed and claimed method of providing the user with contact person information within the career and industry rosters [Application 10/768,929, page 26, lines 5 - 13].

Applicant reiterates the traversal of rejection of claim 13 under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas as detailed herein above. Claim 14 depends upon an allowable claim, claim 13, and, as such, rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Ho/Mascarenhas in further view of Ellis is likewise traversed.

As Applicant has repeatedly demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on Ho/Mascarenhas and Ellis to reject claim 14 under 35 U.S.C. §103(a) ignores the present invention and does not comport with

the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02. The use of Ho and Ellis are particularly misapplied since both references are principally concerned with filling job positions and not with appropriate career parameters as developed and assessed personally by the user through the method/system of the present invention. Thus, Ho and/or Mascarenhas in further view of Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 14.

Accordingly, rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Ho/Mascarenhas in further view of Ellis is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claim 15: As to claim 15, the Examiner cites Ellis as disclosing "creating an action plan including career goals (e.g. objectives) (See Figure 6), steps necessary to achieve each career goals (sic) (e.g. Competency framework) (See Figs.2 and 3), resources needed to achieve each step (e.g. support resources) (See. Fig. 4), completion dates for each step (e.g. end of period) (See Fig.1) and modifying the action plan as necessary (e.g. recharter the team as needed) (See Fig. 6)." [Office Action, page 5].

Applicant reiterates the traversal of rejection of claim 14

under 35 U.S.C. §103(a) as being unpatentable over Ho in view of Mascarenhas and in further view of Ellis as detailed herein above. Claim 15 depends upon an allowable claim, claim 14, and, as such, rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Ellis is likewise traversed.

Ellis' Figure 6 is an action plan limited to specific areas of competency but does not include the assessment aspect of career goals disclosed and claimed in the present invention [Application 10/768,929, page 29, line 9 through page 30, line 20]. Ellis' Figure 4 resources are limited to personal resources in the particular area of competency but does not include the contact persons within an organization for furthering career goals disclosed and claimed in the present invention [Application 10/768,929, page 26, lines 5 - 13]. Finally, Ellis' Figure 1 is open ended as to when competency is achieved and it does not set dates of completion disclosed and claimed in the present invention [Application 10/768,929, page 31, lines 2 - 4]. Hence, Ellis does not support the contentions of the Examiner, substantively or contextually, at least as to these identified areas of disclosure. Accordingly, rejection of claim 15 under 35 U.S.C. §103(a) based upon Ellis is traversed. Thus, Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 15.

As Applicant has further demonstrated herein with respect to



rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on Ellis to reject claim 15 under 35 U.S.C. §103(a) ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02.

Accordingly, rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Ellis is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claims 16 - 20: As to claims 16 - 20, the Examiner cites Mascarenhas as teaching "a memory device, a processor (e.g. CPU) coupled to memory device (see Fig.2), retrieving user's profile (See Fig. 5), Accepting user into system (See Col. 7, 22 - 26)generating prompts (See Col. 7, 30 -36), and securely storing user's input (See Fig. 7, element 713)." The Examiner further cites Mascarenhas as disclosing "that the user accesses the data processing system via the Internet (See Fig.1), wherein the user accesses the data processing system via CD-Rom (See Col. 10, 40-47). The Examiner concedes and admits Mascarenhas fails to specifically disclose user payment means or storing the same, but concludes official notice of such payment means at the time of the present invention would be obvious in view of Mascarenhas.

(Office Action, pages 5 and 6).

Applicant reiterates the traversal of rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Ellis as detailed herein above. Claims 16 - 20 depends ultimately upon an allowable claim, claim 15, and, as such, rejection of claims 16 - 20 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

As previously discussed, the present invention provides an assessment template which integrally synthesizes data from four specific standards wherein a user creates and writes an action plan consistent with the data for a career choice or change. [Application 10/768,929, page 4, line 16 through page 6, line 6]. The results written and edited by the user can then be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10]. This novel system and method of the present invention in the pending application is disclosed and claimed in a manual embodiment [Application 10/768,929, page 5, line 24 through page 6, line 6] and stand-alone or interactive electronic embodiments [Application 10/768,929, page 6, lines 7 - 10]. Mascarenhas is system and method for psychological significance patterning to match users with target information on products, services, and career openings. [Mascarenhas, column 1, lines 36 - 41]. Just because

Mascarenhas employs similar electronic, online or computer aided means to practice a different invention is not sufficient to reject claims 16 - 20 of the present invention under 35 U.S.C. §103(a).

As Applicant has further demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on Mascarenhas to reject claims 16 - 20 under 35 U.S.C. §103(a) ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claims 16 - 20.

Accordingly, rejection of claims 16 - 20 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

C. The Examiner's rejection of claims 22 - 28 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas in view of Ellis is noted.

**Claim 22:** As to claim 22, the Examiner cites Mascarenhas as teaching "a memory device, a processor (e.g. CPU) coupled to memory device (see Fig.2), retrieving user's profile (See Fig.

5), Accepting user into system (See Col. 7, 22 - 26) generating prompts (See Col. 7, 30 -36), and securely storing user's input (See Fig. 7, element 713).” The Examiner further cites Mascarenhas as disclosing “that the user accesses the data processing system via the Internet (See Fig.1), wherein the user accesses the data processing system via CD-Rom (See Col. 10, 40-47). The Examiner concedes and admits Mascarenhas fails to expressly disclose “rproviding (sic) career assessment result to the user.” The Examiner, however, finds that Ellis discloses a method “wherein the result os (sic) skill and competency assessment are presented to the user” (Ellis Abstract) and opines that it would have been obvious to incorporate the features of Ellis into Mascarenhas [Office Action, pages 6 - 7]. The Examiner further admits and concedes neither Mascarenhas/Ellis specifically disclose a method for user's payment means or storing the same, but concludes official notice of such payment means at the time of the present invention would be obvious in view of Mascarenhas and Ellis. (Office Action, page 7).

As previously discussed, the present invention provides an assessment template which integrally synthesizes data from four specific standards wherein a user creates and writes an action plan consistent with the data for a career choice or change. [Application 10/768,929, page 4, line 16 through page 6, line 6]. The results written and edited by the user can then be applied by

third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10]. This novel system and method of the present invention in the pending application is disclosed and claimed in a manual embodiment [Application 10/768,929, page 5, line 24 through page 6, line 6] and stand-alone or interactive electronic embodiments [Application 10/768,929, page 6, lines 7 - 10]. Mascarenhas is system and method for psychological significance patterning to match users with target information on products, services, and career openings. [Mascarenhas, column 1, lines 36 - 41]. Just because Mascarenhas employs similar electronic, online or computer aided means to practice a different invention is not sufficient to reject claims 22 of the present invention under 35 U.S.C. §103(a).

Mascarenhas' retrieving user profile (Fig. 5) does not support the contention of the Examiner, either substantively or contextually, of Applicant's claim 22 because it is limited to the system determining the user's profile (Mascarenhas, column 22, lines 20 - 37). Claim 22 instead specifically relates to user assessments of the various sets (Application 10/768,929, Figs. 1 - 5; Page 10, line 8 through page 11, line 7; page 12, line 24 through page 13, line 11.) Accordingly, rejection of claim 22 under 35 U.S.C. §103(a) based upon Mascarenhas is

traversed.

Ellis is limited to a framework wherein competencies for a career and associated requirements that need to be satisfied to attain the relevant competency are developed for advancement purposes [Ellis, abstract]. Since it is directed only towards competency, Ellis does not use assessment tools to understand any essential career related criteria, for example (i) user values (what is important to them); (ii) user skills (what they are good at); (iii) user interests (naturally occurring urges towards a subject matter or industry); and (iv) user personality (the environment that supports them best) [Application 10/768,929, page 3, lines 9 - 18]. In Ellis, the user does not create and/or write an action plan consistent with the user's assessment results and, as such, the user does not become invested in the optimum outcome for a career change or choice based upon an assessment [Application 10/768,929, page 4, line 16 through page 6, line 6]. Ellis does not provide for assessment results as written and edited by the user to be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10].

As Applicant has further demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on

Mascarenhas/Ellis to reject claim 22 under 35 U.S.C. §103(a) ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Mascarenhas/Ellis reasonably cannot be interpreted to disclose the aforementioned features of independent claim 22.

Accordingly, rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 23:** As to claim 23, the Examiner cites Mascarenhas as further disclosing "means for performing all the features mentioned in claim 22.

Applicant reiterates the traversal of rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 23 depends upon allowable claim 22, and, as such, rejection of claim 23 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above. Thus, Mascarenhas reasonably cannot be interpreted to disclose

the aforementioned features of dependent claim 23.

Accordingly, rejection of claim 23 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claim 24: As to claim 24, the Examiner cites Mascarenhas as disclosing "a method wherein the classification significance pattern is determined for each user, which helps them in a job search." [emphasis added] (Office Action, page 7), and further discloses "personality trait topography wherein the individual's characteristics are listed in a table (See Col. 12, 22-67)." The Examiner concedes and admits Mascarenhas does not "specifically disclose a set of four personality theme (sic) such as organizer, liberator, facilitator and innovator." The Examiner opines the lack of Applicant's disclosed personality categories are for any particular purpose "other than those mentioned in Mascarenhas" it would have been obvious to incorporate the categories into Ho/Mascarenas.

Applicant reiterates the traversal of rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 24 depends upon allowable claim 22, and, as such, rejection of claim 24



under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, and Ho/Mascarenhas for claims 1 - 11 as detailed above. Thus, Mascarenhas and/or Ho/Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 24.

Accordingly, rejection of claim 24 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 25:** As to claim 25, the Examiner cites Ellis/Mascarenhas as disclosing "means for securely generating career assessment results." The Examiner concedes and admits the references do not specifically disclose means for printing the result but under official notice deems it obvious to modify Ellis/Mascarenhas to "allow user's (sic) to keep a record of their assessment result." (Office Action, page 8).

Applicant reiterates the traversal of rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over

Mascarenhas/Ellis as detailed herein above. Claim 25 depends upon allowable claim 22, and, as such, rejection of claim 25 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Mascarenhas and/or Ho/Mascarenhas and/or Ho/Mascarenhas in further view of Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 25.

Accordingly, rejection of claim 25 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 26:** As to claim 26, the Examiner cites Mascarenhas as "further disclosing means for providing personality snapshots (e.g. taking computer based psychological test), means for user to review the personality snapshots and rank personality themes (See Fig.3, Fig.7 and Table I)." (Office Action, page 8).

Applicant reiterates the traversal of rejection of claim 22

under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 26 depends upon allowable claim 22, and, as such, rejection of claim 26 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Mascarenhas cannot be interpreted to disclose the aforementioned features of dependent claim 26.

Accordingly, rejection of claim 26 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claims 27 and 28:** As to claims 27 and 28, the Examiner cites Ellis/Mascarenhas as further disclosing "means for performing the features disclosed in claim 22."

Applicant reiterates the traversal of rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Ellis/Mascarenhas as detailed herein above. Claims 27 and 28

depend upon allowable claim 22, and, as such, rejection of claims 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Ellis/Mascarenhas is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Mascarenhas in further view of Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claims 27 and 28.

Accordingly, rejection of claims 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Ellis/Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

D. The Examiner's rejection of claims 29 - 34 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas in view of Ellis is noted.

**Claim 29:** As to claim 29, the Examiner cites Mascarenhas as disclosing "a data processing system comprising: computer processor, storage medium (e.g. memory) (See Fig.2), means for initializing the storage medium, processing data regarding career

profiles and personality themes (See Abstract), and means for action planning and research (See Table II)." The Examiner admits and concedes Mascarenhas does not specifically disclose that the processing system is for career assessment, but opines that Ellis "discloses a method for career development framework, wherein based on individual's competencies and skills a plan is provided for them" and concludes it would have been obvious to combine Ellis with Mascarenhas "in order to design a system that provides a list of professions that are well suited to the individual's personality." (Office Action, Page 9).

As previously discussed, the present invention provides an assessment template which integrally synthesizes data from four specific standards wherein a user creates and writes an action plan consistent with the data for a career choice or change. [Application 10/768,929, page 4, line 16 through page 6, line 6]. The results written and edited by the user can then be applied by third parties in concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10]. This novel system and method of the present invention in the pending application is disclosed and claimed in a manual embodiment [Application 10/768,929, page 5, line 24 through page 6, line 6] and stand-alone or interactive electronic embodiments [Application 10/768,929, page 6, lines 7 - 10]. Mascarenhas is system and

method for psychological significance patterning to match users with target information on products, services, and career openings. [Mascarenhas, column 1, lines 36 - 41]. Just because Mascarenhas employs similar electronic, online or computer aided means to practice a different invention is not sufficient to reject claims 22 of the present invention under 35 U.S.C. §103(a).

Ellis is limited to a framework wherein competencies for a career and associated requirements that need to be satisfied to attain the relevant competency are developed for advancement purposes [Ellis, abstract]. Since it is directed only towards competency, Ellis does not use assessment tools to understand any essential career related criteria, for example (i) user values (what is important to them); (ii) user skills (what they are good at); (iii) user interests (naturally occurring urges towards a subject matter or industry); and (iv) user personality (the environment that supports them best) [Application 10/768,929, page 3, lines 9 - 18]. In Ellis, the user does not create and/or write an action plan consistent with the user's assessment results and, as such, the user does not become invested in the optimum outcome for a career change or choice based upon an assessment [Application 10/768,929, page 4, line 16 through page 6, line 6]. Ellis does not provide for assessment results as written and edited by the user to be applied by third parties in

concert with the user, for final implementation or as part of an ongoing action plan [Application 10/768,929, page 6, line 11 through page 7, line 10].

As Applicant has further demonstrated herein with respect to rejection of claims 1 - 9 as being unpatentable over Ho in view of Mascarenhas, the Examiner's similar reliance on Mascarenhas/Ellis to reject claim 29 under 35 U.S.C. §103(a) ignores the present invention and does not comport with the requirements of either *Graham* or MPEP §2111 and/or MPEP §2141.02. Thus, Mascarenhas/Ellis reasonably cannot be interpreted to disclose the aforementioned features of independent claim 29.

Accordingly, rejection of claim 29 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 30:** As to claim 30, the Examiner cites Ellis as further disclosing "inputting and storing a plurality of values sets, skill sets and career interests (See Fig.3)." (Office Action, page 9)

Applicant reiterates the traversal of rejection of claim 29 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claims 30 depends

upon allowable claim 29, and, as such, rejection of claim 30 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis is likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas/Ellis specifically for claims 22 - 28 as detailed above.

Thus, Mascarenhas/Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 30.

Accordingly, rejection of claim 30 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 31:** As to claim 31, the Examiner opines Mascarenhasem) (See Col.7, 22-26) and means for performing all the features disclosed in claim 29 (e.g., computer medium)." (Office Action, pages 9 - 10).

Applicant reiterates the traversal of rejection of claim 29 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 31 depends upon allowable claim 29, and, as such, rejection of claim 31 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.



Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas/Ellis specifically for claims 22 - 28 as detailed above, and Ho/Mascarenhas for claims 1 - 11 as detailed above. Thus, Mascarenhas/Ellis and/or Ho/Mascarenhas reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 31.

Accordingly, rejection of claim 31 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

Claim 32: As to claim 32, the Examiner cites Mascarenhas as further disclosing "identifying the storage medium (See Col.7, 22-26); providing description of personality snapshots (See Col.12, 34-Cxol.14,34) (sic), and ranking the personality themes (See Col.21, Table II). means for securely generating career assessment results." (Office Action, page 10).

Applicant reiterates the traversal of rejection of claim 31 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 32 depends upon allowable claim 31, and, as such, rejection of claim 32 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is

likewise traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Mascarenhas and/or Ho/Mascarenhas and/or Ho/Mascarenhas in further view of Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 32.

Accordingly, rejection of claim 32 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art ad ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 33:**<sup>2</sup> As to claim 33, the Examiner cites Mascarenhas/Ellis as disclosing "all the features disclosed in Claim 32" but concedes and admits Mascarenhas/Ellis "does not disclose refining user's research." but opines "Ho discloses such in his invention (See Fig.16A, element 775)." and further opines it would be obvious to incorporate the features of Ho in Mascarenhas/Ellis (Office Action, page 8).

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<sup>2</sup> The Examiner's details for rejecting claim 33 appears on page 6 of the Office Action under the aggregation of Ho, Mascarenhas and Ellis for claims 12 - 20 and 33.

Applicant reiterates the traversal of rejection of claim 32 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas/Ellis as detailed herein above. Claim 33 depends upon allowable claim 32, and, as such, rejection of claim 33 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is likewise traversed.

Ho (Fig.16A, element no. 775) does not support the contention of the Examiner, either substantively or contextually, but instead specifically relates to updating user information for identifying a job or ascertaining one learning object (Ho, Col. 16, lines 7 - 29). Applicant's claim 33 addresses the disclosed methodology whereby the user's research on career options and industries are refined based upon the user's use of information on how to find contact persons, network, and sample interview questions. (Application 10/768,929, Fig. 7, element number 720; Page 28, line 11 through page 29, line 7.) Accordingly, rejection of claim 33 under 35 U.S.C. §103(a) based upon Ho is traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Ho/Mascarenhas in further view of Ellis cannot be interpreted to

disclose the aforementioned features of dependent claim 33.

Accordingly, rejection of claim 33 under 35 U.S.C. §103(a) as being unpatentable over Mascarenhas is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Claim 34:**<sup>3</sup> As to claim 34, the Examiner cites Ellis as disclosing "retrieving from storage medium an action plan (see Fig.2, and Fig.3). Ellis further discloses providing current date (e.g. date of completion of the requirement) on the action plan, career goals and objectives, and steps necessary to achieve each career goal (e.g. requirements) (See Fig.6)." The Examiner further opines "Mascarenhas discloses that users may log into the system (See Col.7, 23-26)." The Examiner concedes and admits Ellis/Mascarenhas "does not expressly disclose prioritizing the steps necessary to achieve a career goal" however, by official notice concludes it is obvious to prioritize the requirements that leads to achieving a goal, and therefore obvious to so modify Ellis/Mascarenhas. (Office Action, Pages 8 - 9).

Applicant reiterates the traversal of rejection of claim 33 under 35 U.S.C. §103(a) as being unpatentable over

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<sup>3</sup> The Examiner's details for rejecting claim 34 appears on page 8 of the Office Action under the aggregation of Mascarenhas and Ellis for claims 22 - 28.

Ellis/Mascarenhas as detailed herein above. Claim 34 depends upon allowable claim 33, and, as such, rejection of claim 34 under 35 U.S.C. §103(a) as being unpatentable over Ellis/Mascarenhas is likewise traversed.

Ellis (Fig.2, and Fig.3) does not support the contention of the Examiner, either substantively or contextually, but instead discloses use of an action plan to evaluate competency development. Applicant's claim 34 addresses an action plan which is the outcome of the user created and written and self-assessment steps provided under the method of the present invention. (Application 10/768,929, Fig. 7, element number 720; Page 4, line 16 through page 5, line 4; Fig. 8, Element Nos. 800 - 826 ) Accordingly, rejection of claim 34 under 35 U.S.C. §103(a) based upon Ellis is traversed.

Further, Applicant incorporates by reference as if fully set forth under this claim, the traversal as to Mascarenhas specifically for claims 16 - 20, and 22 as detailed above, Ho/Mascarenhas for claims 1 - 11 as detailed above, and Ho/Mascarenhas in further view of Ellis for claims 12 - 20. Thus, Mascarenhas in further view of Ellis reasonably cannot be interpreted to disclose the aforementioned features of dependent claim 34.

Accordingly, rejection of claim 34 under 35 U.S.C. §103(a) as being unpatentable over Ellis/Mascarenhas is traversed as failing

to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively.

**Conclusion:**

In view of the above, it is submitted that the pending independent claims 1, 22 and 29 patentably define the present invention over the citations of record, and the required *Graham* factors are not met by the Examiner's references. Applicant respectfully requests reconsideration of the rejections of independent claims 1, 22 and 29, and withdrawal of these claim rejections. Further, dependent claims 2 - 21, 23 - 28, and 30 - 34 should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual reconsideration of dependent claims 2 - 21, 23 - 28, and 30 - 34 is respectfully requested.

Reconsideration and withdrawal of the claim rejections for claims 1 - 20, and 22 - 34, under 35 U.S.C. §103(a) are hereby respectfully requested. Allowance of claims 1 through 34 is earnestly solicited.

Applicant respectfully requests that the Patent Office resolve any remaining informalities by telephone conference interview with Applicant's Attorney to expedite prosecution.

Dated: March 17, 2008.

Respectfully submitted,  
/Charles L. Thoeming/  
Charles L. Thoeming  
Customer Number 27015  
Registration No. 43,951  
Bielen, Lampe & Thoeming, P.A.  
1390 Willow Pass Road  
Suite 1020  
Concord, CA 94520  
(925)288.9720  
(925)288.9731 Facsimile  
Attorneys for Applicant

Enclosures:

**Certificate of Filing by Electronic Means**

I hereby certify that this correspondence with the referenced petition for extension of time, required small entity fee for a three month extension of time, replacement drawing Figs. 1- 12, annotated drawing Figs. 1 - 12, and transmittal cover sheet are being filed using the undersigned's customer number and secure EFS identification through the USPTO EFS filing system, on March 17, 2008.

Name of Person Signing Certificate: Charles L. Thoeming

Signed: /Charles L. Thoeming/

Date of Signing: March 17, 2008

cc: Client (w/encl.)